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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,514	07/16/2003	Ricardo M. Attar	D0287 NP	3956
23914	7590	09/01/2006	EXAMINER	
LOUIS J. WILLE BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			HAMA, JOANNE	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/620,514

Applicant(s)

ATTAR ET AL.

Examiner

Joanne Hama, Ph.D.

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 112, 2nd.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 1-13 and 18-20.
Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____

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Applicant filed a response to the Final Action of June 16, 2006 on August 15, 2006. Claims 1-4, 7, 11, 12, 13, 20 are amended. Claims 14-17 are cancelled.

Claims 1-13, 18-20 are under consideration.

Withdrawn Rejection

35 U.S.C. § 112, 2nd parag.

Applicant's arguments, see page 6 of Applicant's response, filed August 15, 2006, with respect to the rejection of claim 7 have been fully considered and are persuasive. Applicant has amended the claim. The rejection of claim 7 has been withdrawn.

New/Maintained Rejections

35 U.S.C. § 101

Applicant's arguments filed August 15, 2006 have been fully considered but they are not persuasive. Applicant indicates that the claims have been amended to indicate that the claimed mouse exhibits enhanced expression of androgen receptor relative to a wild type mouse. Applicant indicates that the transgenic mice provide a model system to monitor activity of androgen receptor in different organs and tissues. As such, Applicant asserts that the claimed invention has utility because it can be used to study the mouse tissue's selective activity of pharmacological agents by inhibition or activation of androgen receptor in different organs and tissues (Applicant's response, page 5-6). In response, Applicant's response is not persuasive because as indicated in the Office

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Action of December 29, 2005, pages 4-5, studying the effects of the transgene's overexpression in a mouse is a general, rather than a specific utility of the claimed mouse. The Office Action also indicates that the transgenic mice described in the specification's Examples do not have any phenotype. The use of a transgenic mouse with no phenotype is not readily apparent. Thus, the rejection remains.

35 U.S.C. § 112, 1st parag.

Applicant's arguments filed August 15, 2006 have been fully considered but they are not persuasive. Applicant indicates that the specification enables one of skill in the art to make and (in view of the arguments above concerning the rejection under 35 U.S.C. § 101) use the claimed invention (Applicant's response, page 6). In response, as discussed above in the 35 U.S.C. § 101 rejection, the claimed mice have no readily apparent use and thus, the rejection of these claims remain.

35 U.S.C. § 112, 2nd parag.

The "transgenic non-human mammal" of claim 18 lacks antecedent basis. The scope of claim 1 is to a mouse and is not as broad as any non-human mammal.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Hama, Ph.D. whose telephone number is 571-

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272-2911. The examiner can normally be reached Monday through Thursday and alternate Fridays from 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, Ph.D. can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file

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JH

ANNE M. WEHBE PH.D
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'Anne M. Wehbe', with a long horizontal line extending from the end of the signature.